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10/616,379	07/09/2003	Skott C. Klebe	94448	1320

22242 7590 10/27/2010		
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EXAMINER
TRUVAN, LEYNNA THANH

ART UNIT	PAPER NUMBER
2435	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

    A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 January 2010</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail. Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-30 remains pending.

2.   In view of the Pre-appeal Brief filed on 1/21/10, PROSECUTION IS HEREBY

REOPENED. A Non-Final Rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

     (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

     (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed

by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and

appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth

in 37 CFR 41.20 have been increased since they were previously paid, then appellant

must pay the difference between the increased fees and the amount previously paid.

     A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by

signing below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21-30 recite "the computer program product comprising a computer usable medium having computer readable program code thereon". The computer readable media can execute or comprise a computer program product thereon. However, for a computer program product <u>comprising</u> a usable medium thereon is not a computer but rather software. Thus, the claimed computer program product is directed to software program per se.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   **Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wason, et al. (US 7,568,152) in view of Romansky, et al. (US 6,535,871).**

<u>As per claim 1:</u>   Wason discloses a method for distributing secure digital content that can be indexed by third party search engines, the method comprising:

generating a text stream **(col.7, lines 65-67)** from the digital content by stripping

all graphic information and punctuation from the digital content; **(col.2, line 60-col.3,**

line 2 and col.11, lines 35-67)

fragmenting the text stream into multi-word phrases that are each contained in

the digital content; **(col.4, lines 16-17 and 50-57 and col.8, lines 37-60)**

randomly assembling the phrases into a scrambled document such that the

scrambled document contains at least nearly all of the words and at least most of the

phrases as are contained in the digital content; and **(col.8, lines 25-35 and col.9, lines**

15-35)

making the scrambled document available to the third party search engines to

permit indexing of the scrambled document **(col.5, lines 20-60 and col.6, lines 1-67)**

that will result in an index that is comparable to an index that would result if the third

party search engine indexed the digital content. **(col.12, lines 30-50 and col.14, lines**

25-67)

Wason discloses an invention to improve text file processing where the method

comprises the steps of forming a template from fragments of the text file, using the

template as an overlay for parsing incoming files or to generate a segment of an output

file, and using the macro class to map data from the text file to an application (col.1, line

55-col.2, line 5). However, Wason did not clearly disclose randomly assembling the

phrases into a scrambled document.

Romansky discloses allows a search engine to find a document allowing a

potential buyer to review portions of the document. The invention provides a plain text

index to the document that may be searched by search engines and reviewed by

potential buyers of the document (col.1, lines 58-67). Romansky discloses the

searchable synchronized index is in plain text in a digital container that protects by

encryption a DRM-controlled document. Inclusion of the index in the same digital

container as the controlled document ensures proper synchronization of the index and

the document (col.2, lines 5-10). Romansky further discloses the publisher of the

document is also given the ability to change the order or relationship of some key words

from the searchable synchronized index that may reveal sensitive information or

information the publisher does not want to disclose. For instance, the words "ABC

Electronics, Inc.", "strong", and "buy" may not be revealing in isolation, but the phrase

"ABC Electronics, Inc. strong buy" may have special meaning if it appears in an

analyst's report about ABC Electronics, Inc. Thus, the relationship or combination of

some key words may be significant. One way to conceal the relationship or

combination of certain key words is randomizing the searchable synchronized index of

key words. Another method for concealing the relationship or combination of certain

key words is to use a context independent hashing rule, i.e., storing the key words in

alphabetical order (col.2, lines 25-41).

    Therefore, it would have been obvious for a person of ordinary skills in the art to

combine the teachings of Coston-Oliver with Romansky to teach randomly assembling

the phrases into a scrambled document because to conceal sensitive information that

may not want to be disclosed (Romansky-col.2, lines 25-41).

As per claim 2:   **See Wason on col.2, line 60-col.3, line 2 and col.7, lines 65-67:** discussing a method of claim 1 wherein step comprises parsing the text stream to generate a word stream and fragmenting the word stream into phrases, where each phrase contains at least two words.

As per claim 3:   **See Romansky on col.2, lines 25-41:** discussing the method of claim 2 wherein the total number of words in a phrase is random.

As per claim 4:   **See Wason on col.8, lines 25-35 and col.9, lines 15-35;** discussing the method of claim 3 wherein the total number of words in a phrase has a maximum of five words.

As per claim 5:   **See Romansky on col.2, lines 25-41;** discussing the method of claim 1 wherein the randomly assembling step comprises forming a stream of phrases and randomly swapping the position of phrases in the phrase stream.

As per claim 6:   **See Wason on col.10, lines 10-67 and col.11, lines 35-67:** discussing the method of claim 1 further comprising: (e) returning the scrambled document content when the scrambled document is indexed by the third party search engines.

As per claim 7:   **See Wason on col.12, lines 30-50 and col.14, lines 25-67:** discussing a method of claim 6 wherein the returning step comprises examining a user agent parameter to determine whether a search engine or a browser is requesting the scrambled document.

As per claim 8:   **See Wason on col.12, lines 30-50 and col.14, lines 25-67:** discussing the method of claim 6 further comprising: returning a link to an owner of the

secure content when a browser links from the search engine to the indexed scrambled document.

As per claim 9:   See Wason on col.5, lines 20-60 and col.6, lines 1-67; discussing the method of claim 8 wherein the scrambled document contains a script routine that loads a web page provided by the secure content owner and the returning a link step comprises running the script routine after the scrambled document content has been loaded into the browser.

As per claim 10:   See Wason on col.7, lines 65-67and Romansky on col.2, lines 25-41: discussing the method of claim 9 wherein the returning a link step comprises using the script routine to hide the scrambled text from a user.

<u>**As per claim 11:**</u>   Wason discloses apparatus for distributing secure digital content that can be indexed by third party search engines, the apparatus comprising:

a stripper that generates a text stream **(col.7, lines 65-67)** from the digital content by stripping all graphic information and punctuation from the digital content; **(col.2, line 60-col.3, line 2 and col.11, lines 35-67)**

means for fragmenting the text stream into multi-word phrases that are each contained in the digital content; **(col.4, lines 16-17 and 50-57 and col.8, lines 37-60)**

a stream assembler that randomly assembles the phrases into a scrambled document such that the scrambled document contains at least nearly all of the words and at least most of the phrases as are contained in the digital content; and **(col.8, lines 25-35 and col.9, lines 15-35)**

means for making the scrambled document available to the third party search engines to permit indexing of the scrambled document **(col.5, lines 20-60 and col.6, lines 1-67)** that will result in an index that is comparable to an index that would result if the third party search engine indexed the digital content.   **(col.12, lines 30-50 and col.14, lines 25-67)**

Wason discloses an invention to improve text file processing where the method comprises the steps of forming a template from fragments of the text file, using the template as an overlay for parsing incoming files or to generate a segment of an output file, and using the macro class to map data from the text file to an application (col.1, line 55-col.2, line 5). However, Wason did not clearly disclose randomly assembling the phrases into a scrambled document.

Romansky discloses allows a search engine to find a document allowing a potential buyer to review portions of the document. The invention provides a plain text index to the document that may be searched by search engines and reviewed by potential buyers of the document (col.1, lines 58-67). Romansky discloses the searchable synchronized index is in plain text in a digital container that protects by encryption a DRM-controlled document. Inclusion of the index in the same digital container as the controlled document ensures proper synchronization of the index and the document (col.2, lines 5-10). Romansky further discloses the publisher of the document is also given the ability to change the order or relationship of some key words from the searchable synchronized index that may reveal sensitive information or information the publisher does not want to disclose. For instance, the words "ABC

Electronics, Inc.", "strong", and "buy" may not be revealing in isolation, but the phrase

"ABC Electronics, Inc. strong buy" may have special meaning if it appears in an

analyst's report about ABC Electronics, Inc. Thus, the relationship or combination of

some key words may be significant. One way to conceal the relationship or

combination of certain key words is randomizing the searchable synchronized index of

key words. Another method for concealing the relationship or combination of certain

key words is to use a context independent hashing rule, i.e., storing the key words in

alphabetical order (col.2, lines 25-41).

Therefore, it would have been obvious for a person of ordinary skills in the art to

combine the teachings of Coston-Oliver with Romansky to teach randomly assembling

the phrases into a scrambled document because to conceal sensitive information that

may not want to be disclosed (Romansky-col.2, lines 25-41).

As per claim 12:   See Wason on col.2, line 60-col.3, line 2 and col.7, lines 65-67;

discussing the apparatus of claim 11 wherein the means for fragmenting comprises a

parser that parses the text stream to generate a word stream and a fragmented that

fragments the word stream into phrases, where each phrase contains at least two

words.

As per claim 13: See Romansky on col.2, lines 25-41; discussing the apparatus of

claim 12 wherein the total number of words in a phrase is random.

As per claim 14:   See Wason on col.8, lines 25-35 and col.9, lines 15-35;

discussing the apparatus of claim 13 wherein the total number of words in a phrase has

a maximum of five words.

As per claim 15:   See Romansky on col.2, lines 25-41; discussing the apparatus of claim 11 wherein the stream assembler comprises means for forming a stream of phrases and means for randomly swapping the position of phrases in the phrase stream.

As per claim 16:   See Wason on col.10, lines 10-67 and col.11, lines 35-67; discussing the apparatus of claim 11 further comprising means for returning the scrambled document content when the scrambled document is indexed by the third party search engines.

As per claim 17:   See Wason on col.12, lines 30-50 and col.14, lines 25-67; discussing the apparatus of claim 16 wherein the means for returning the scrambled document content comprises means for examining a user agent parameter to determine whether a search engine or a browser is requesting the scrambled document.

As per claim 18:   See Wason on col.5, lines 20-60 and col.6, lines 1-67; discussing the apparatus of claim 16 further comprising means for returning a link to an owner of the secure content when a browser links from the search engine to the indexed scrambled document.

As per claim 19:   See Wason on col.12, lines 30-50 and col.14, lines 25-67: discussing the apparatus of claim 18 wherein the scrambled document contains a script routine that loads a web page provided by the secure content owner and the means for returning a link to an owner of the secure content comprises means for running the script routine after the scrambled document content has been loaded into the browser.

As per claim 20:   **See Romansky on col.2, lines 25-41 :** discussing the apparatus of

claim 19 wherein the script routine comprises means for hiding the scrambled text from

a user.

<u>**As per claim 21:**</u>   Wason discloses a computer program product for distributing

secure digital content that can be indexed by third party search engines, the computer

program product comprising a computer usable medium having computer readable

program code thereon, including:

program code for generating a text stream **(col.7, lines 65-67)** from the digital

content by stripping all graphic information and punctuation from the digital content;

(col.2, line 60-col.3, line 2 and col.11, lines 35-42)

program code for fragmenting the text stream into multi-word phrases that are

each contained in the digital content; **(col.4, lines 16-17 and 50-57 and col.8, lines

37-60)**

program code for randomly assembling the phrases into a scrambled document

such that the scrambled document contains at least nearly all of the words and at least

most of the phrases as are contained in the digital content; and   **(col.8, lines 25-35

and col.9, lines 15-35)**

program code for making the scrambled document available to the third party

search engines to permit indexing of the scrambled document **(col.5, lines 20-60 and

col.6, lines 1-67)** that will result in an index that is comparable to an index that would

result if the third party search engine indexed the digital content.   **(col.12, lines 30-50

and col.14, lines 25-67)**

Wason discloses an invention to improve text file processing where the method comprises the steps of forming a template from fragments of the text file, using the template as an overlay for parsing incoming files or to generate a segment of an output file, and using the macro class to map data from the text file to an application (col.1, line 55-col.2, line 5). However, Wason did not clearly disclose randomly assembling the phrases into a scrambled document.

Romansky discloses allows a search engine to find a document allowing a potential buyer to review portions of the document. The invention provides a plain text index to the document that may be searched by search engines and reviewed by potential buyers of the document (col.1, lines 58-67). Romansky discloses the searchable synchronized index is in plain text in a digital container that protects by encryption a DRM-controlled document. Inclusion of the index in the same digital container as the controlled document ensures proper synchronization of the index and the document (col.2, lines 5-10). Romansky further discloses the publisher of the document is also given the ability to change the order or relationship of some key words from the searchable synchronized index that may reveal sensitive information or information the publisher does not want to disclose. For instance, the words "ABC Electronics, Inc.", "strong", and "buy" may not be revealing in isolation, but the phrase "ABC Electronics, Inc. strong buy" may have special meaning if it appears in an analyst's report about ABC Electronics, Inc. Thus, the relationship or combination of some key words may be significant. One way to conceal the relationship or combination of certain key words is randomizing the searchable synchronized index of

key words. Another method for concealing the relationship or combination of certain

key words is to use a context independent hashing rule, i.e., storing the key words in

alphabetical order (col.2, lines 25-41).

Therefore, it would have been obvious for a person of ordinary skills in the art to

combine the teachings of Coston-Oliver with Romansky to teach randomly assembling

the phrases into a scrambled document because to conceal sensitive information that

may not want to be disclosed (Romansky-col.2, lines 25-41).

As per claim 22:   See Wason on col.2, line 60-col.3, line 2 and col.7, lines 65-67;

discussing the computer program product of claim 21 wherein the program code for

fragmenting the text stream comprises program code for parsing the text stream to

generate a word stream and program code for fragmenting the word stream into

phrases, where each phrase contains at least two words.

As per claim 23: See Romansky on col.2, lines 25-41; discussing the computer

program product of claim 22 wherein the total number of words in a phrase is random.

As per claim 24: See Wason on col.8, lines 25-35 and col.9, lines 15-35;

discussing the computer program product of claim 23 wherein the total number of words

in a phrase has a maximum of five words.

As per claim 25: See Romansky on col.2, lines 25-41; discussing the computer

program product of claim 21 wherein the program code for randomly assembling the

phrases into a scrambled document comprises program code for forming a stream of

phrases and program code for randomly swapping the position of phrases in the phrase

stream.

As per claim 26: See Wason on col.10, lines 10-67 and col.11, lines 35-67

Romansky on col.2, lines 25-41; discussing the computer program product of claim 21 further comprising program code for returning the scrambled document content when the scrambled document is indexed by the third party search engines.

As per claim 27: See Wason on col.12, lines 30-50 and col.14, lines 25-67; discussing the computer program product of claim 26 wherein the program code for returning the scrambled document content comprises program code for examining a user agent parameter to determine whether a search engine or a browser is requesting the scrambled document.

As per claim 28: See Wason on col.5, lines 20-60 and col.6, lines 1-67; discussing the computer program product of claim 26 further comprising program code for returning a link to an owner of the secure content when a browser links from the search engine to the indexed scrambled document.

As per claim 29:   See Wason on col.12, lines 30-50 and col.14, lines 25-67; discussing the computer program product of claim 28 wherein the scrambled document contains a script routine that loads a web page provided by the secure content owner and the program code for returning the scrambled document content comprises program code for running the script routine after the scrambled document content has been loaded into the browser.

As per claim 30: See Romansky on col.2, lines 25-41; discussing the computer program product of claim 29 wherein the script routine comprises program code for hiding the scrambled text from a user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leynna T. Truvan whose telephone number is (571) 272-3851. The examiner can normally be reached on Monday - Thursday (7:00 - 5:00PM) and telework on Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. T. T./
Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435